

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Art Unit: 1615

#4

Inventor: Milton HODOSH

Serial Number: 09/072,504

Filing Date: May 4, 1998

For: METHOD AND COMPOSITION FOR  
PREVENTING TOOTH HYPERSENSITIVITY  
WHEN USING PASSIVE BLEACHING AGENTS

**PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT  
(37 C.F.R. §1.102 AND M.P.E.P. §708.02)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

November 23, 1998

Sir:

Applicant hereby petitions to make this application special because of actual infringement.  
Accompanying this petition is a Statement of Facts in Support of Petition to Make Special  
Because of Actual Infringement.

The petition fee of \$130.00 is enclosed.

An early and favorable decision on the petition is earnestly solicited.

Respectfully Submitted,

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By: 

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For: METHOD AND COMPOSITION FOR  
PREVENTING TOOTH HYPERSENSITIVITY  
WHEN USING PASSIVE BLEACHING AGENTS

**STATEMENT OF FACTS IN SUPPORT OF PETITION  
TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT  
(M.P.E.P. §708.02)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

I, Carey Lyons of 414 Lewelen Circle, Englewood, New Jersey 07631, am Vice President of Marketing and Sales of the assignee of the above-referenced application, Sultan Chemists, Inc., of 85 West Forest Avenue, Englewood, New Jersey 07631, and am knowledgeable about the inventions disclosed in the application.

The inventions disclosed in the application are orally compatible dental bleaching compositions such as gels and methods for preventing tooth hypersensitivity during bleaching using such compositions. The dental bleaching compositions include a peroxide-releasing compound and a potassium-containing compound, e.g., potassium nitrate. An important feature of the bleaching compositions in accordance with the invention is that they contain the potassium-containing compound which provides a significant advantage because it reduces tooth sensitivity during the

bleaching process.

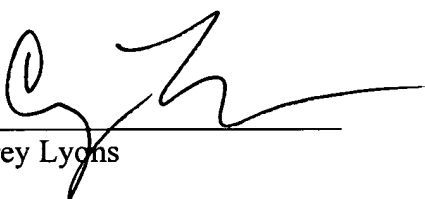
There is actual infringement of at least one of the claimed bleaching compositions.

To wit, I recently saw an advertisement for an orally compatible dental bleaching gel sold under the name "Rembrandt Xtra-Comfort Non-Sensitizing Bleaching Gel" in a trade journal (a copy of the advertisement is attached) and ordered a sample of the gel. Upon receipt of a kit including the gel, I reviewed the listed contents of the gel as set forth on a label (a copy of which is attached hereto) in order to determine whether the gel includes the same ingredients as any of the compositions claimed in the above-referenced application. I noted that in fact, the gel includes the same primary ingredients as the compositions claimed in the application, namely, a peroxide-releasing compound (urea peroxide) and a potassium-containing compound (potassium nitrate).

I therefore read the claims of the application and made a rigid comparison of the gel to at least some of the broader claims. In my opinion, at least independent claim 1 on file in this application is unquestionably infringed. Although the claim requires a specific percentage by weight of the potassium-containing compound in the composition, I contacted the manufacturer of the gel and was advised that there is only a "small amount" of potassium nitrate in the gel. In my opinion, in order to be effective, there must be at least 1% percent by weight of potassium nitrate in the gel.

Further, I have good knowledge of the pertinent prior art, namely, the art which was uncovered in a patent search performed in connection with the preparation of the application by the assignee's patent counsel as well as the art uncovered in a supplementary search performed in light of the infringing activity discussed above. All such material is available to the Examiner in an Information Disclosure Statement previously submitted as well as in another Information Disclosure Statement submitted herewith.

Lastly, as the claims in this application have been drafted in consideration of the prior art uncovered during the search performed in connection with the preparation of the application and since the art uncovered in the supplementary search does not appear to be any more relevant, I believe that the pending claims are allowable.

  
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Carey Lyons

11.16.88  
Date